

## APPLICANT'S REMARKS / ARGUMENTS

1. In response to "Allowable Subject Matter" (item 1) in the Office action, Examiner cites Kowalski '128 as reason for rejections of claim 18's allowance. Applicant respectfully disagrees on the applicability of Kowalski '128 as a 103 reference and applicant will make further arguments below.

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2. In response to "Priority" (item 2) in the Office action:  
Applicant thanks Examiner for acknowledgment of priority documents.

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3. In response to "Information Disclosure Statement" (item 3) in the Office action,  
Applicant thanks examiner for noting and inserting the IDS into the application.

of (10)

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4. In response to "Claim Rejections – §35 USC 112" (item 5) in the Office action,  
Applicant removes extraneous phrase "**said section with**". Doing so will result in a claim 6 meets the tests of §35 USC 112.

of (10)

5. In response to "Claim Rejections – §35 USC 102" (item 7):

The examiner considers item 24 of Hernandez '974 a "head" section, which Examiner believes is analogous to the head section of the current invention. Applicant respectfully argues that because Hernandez '974's item 24 is specifically designed to be "break away" in nature, and is therefore not the head section of the current invention, as the head section of the current invention stays in the body piercing attached to the body piercing section. In fact, element 24 in Hernandez '974 is in fact a decorative section.

In the current invention, the head section attaches to the body piercing section in such a way that it cannot be removed in a breakaway manner (i.e. the head section is screwed onto the body piercing section. The head section of the current invention is deliberately removably attached, not inadvertently removably attached)

Further, Hernandez '974 states in column 3, line 30:

**"Another ornament or dome different from dome 14 is shown in FIG. 3 as element 24."**

Dome 14 in Hernandez '974 is the removable, decorative section of Hernandez '974. It is clear, therefore, that Hernandez believes element 24 to be a decorative section, which happens to have another connection for a second ornament. This belief is

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bolstered by the fact that the entire patent to Hernandez is directed toward "break-away earring ornaments".

Further, because element 24 is not a head section as envisioned by the current invention and due to the break away nature of element 14 & 24, Applicant respectfully requests that Examiner remove the anticipation rejections of claims 1, 14, 15, and 21 due to Hernandez '974.

6. In response to "Claim Rejections" (item 8) in the Office action:

Johnson '492 discloses, similarly to Hernandez '974 a break away element 15 as a snap connector permanently attached to a pendant ornament 14 (column 9 at line 44). Examiner believes this a "head" section, which Examiner believes is analogous to the head section of the current invention.

Applicant respectfully argues that due to the fact that element 15 is detachable from the post but permanently attached to the decorative element, it is part of the decorative section, similarly, again, to the decorative element parts 14 & 24 of Hernandez '974.

As Examiners interpretation of Applicants claims 1, 2, 3, 6-10, 12, 13 & 24 relate to Examiner's belief that Johnson '492's element 15 is a head section analogous to the head section of the current invention, Applicant respectfully requests that Examiner remove the anticipation rejections of claims 1, 2, 3, 6-10, 12, 13, and 24 due to Johnson '492 without applicant arguing separately about each claim's rejection.

7. In response to "Claim Rejection - §35 USC 103" (items 10) in the Office action

- Applicant respectfully requests Examiner consider the above arguments against Hernandez '974 as proof that Hernandez '974 is not a reference "substantially as claimed". Applicant believes that because Hernandez '974 has no head section, and is not substantially as claimed, Hernandez '974 cannot be used in combination with Erickson '036.
- Applicant respectfully requests the Examiner consider that the invention that would result from all combinations of Hernandez '974 with Erickson '036 is not the Applicant's current invention. Specifically:
  - There is no head section, with an attachment for both a decorative section and a body piercing section which head section holds fast the body piercing section, in either Hernandez '974 or Erickson '036, and combining Erickson '036 with Hernandez '974 would allow one skilled in the art to remove a decorative section but not while leaving a head section in place.

- The head section of the current invention is designed to threadingly engage the body piercing section as a means to secure the fastening section, body piercing section, and head section in the body opening. In the current invention these three sections remain fixed in place while the decorative section(s) can be changed. In both Hernandez '974 and Erickson '036 the body piercing section itself makes the "quick disconnect" feature a prime object of the invention. In the current invention there is no such feature. It is clear, therefore, that both Hernandez '974 and Erickson '036 "teach away" from the concept of a fixed in place head section.
- The choice of a friction engaging or threaded decorative section in the current invention is one of manufacturing and user choice. The point of the head section of the current invention is to allow a user to choose which decorative section to use while leaving the head, body piercing and fastening sections in place. In the current invention Applicant shows the head, body piercing and fastening sections having threads for the purpose of securely holding the three sections while a decorative section can be changed. The threads of the head section, therefore, are examples of an attachment that is required to ensure the fastening, body piercing, and head sections stay in the body opening. While some other form of removable attachment may be used, it is clear that the cited references are designed to detach when inadvertently stressed. The current invention intends to have the head, body piercing and fastening sections removable when desired, not inadvertently.
- Hernandez '974 and Erickson '036 do not mention an infection risk, nor do they mitigate an infection risk, as does the Applicant's current invention. Both Hernandez '974 and Erickson '036 are simply earring posts inserted in the ear in the manner that is well known in the art. The Applicant's current invention holds the body piercing section in place even when changing a decorative section.

Applicant respectfully requests that Examiner remove the obviousness rejections of claims 16, and 17 due to Hernandez '974 in view of Erickson '036.

8. In response to "Claim Rejection - §35 USC 103" (items 11) in the Office action:

- Applicant respectfully believes the examiner is confusing the angles in claim 29. Claim 29 codifies the disclosures indication that the angle  $\alpha$  between the body piercing section and the decorative section is between 90 and about 135 degrees (see paragraph [31.] of current application). This angle is different from the angle  $\beta$  of the body piercing section (see paragraph [33.] of current application). Both angles are required by the current invention in order to have the decorative section facing a viewer. Both angles are related and somewhat variable, as defined in the specification of the invention and depend upon where the piercing is indented to go.

- In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) requires "persuasive evidence" for a configuration change to not be considered obvious. To satisfy this requirement, Applicant respectfully references the following paragraph from the USENET Internet News Group **rec.arts.bodyart:s Piercing FAQ 2D—Body Piercings & Their Suggested Jewelry**" (Modified March 4, 1996 by Anne Greenblat):

*We have all seen irritated and inflamed navel piercings; many develop discolored and hardened tissue around the openings. Some migrate and/or "grow out." This happens because the jewelry is too small and needs to move through the tissue to a position where it is no longer under stress. Removing the ring and replacing it with a curved barbell has always solved these problems, usually within days. A curved barbell allows the body to move naturally without stress to the piercing and will not cause any of the undesirable effects associated with the use of a ring.*

- This curved barbell is current invention; with the exception that one end of the barbell is replaced by a head section having two attachments, which allow the piercing to stay in place while replacing decorative sections, while disposing the decorative section at the proper angle so as to be displayed in the manner required by a user and viewer.
- The angle Applicant discloses between the primary and secondary axis of the body piercing section is significant and necessary for the current invention, in that an angle of 180 degrees might be difficult for a user to insert in a body piercing other than an ear piercing, where the entrance and exit openings are substantially "in line". A body piercing, such as in the belly, arms, etc, require curved piercing sections to, as stated in the reference above, "move through the tissue to a position where it is no longer under stress".
- The angle Applicant discloses between the two axes of the head section depend upon the angle of the two axes of the body piercing section, such that the decorative section is in view when installed in a particular body opening.
- It is the fact that the head section of the Applicant's current invention keeps the body piercing section in place and allows the removal of the decorative section without removal of the body piercing section that mitigates infection risk and risk of loss of the body piercing section, head or attachment sections that is the non-obvious step Applicant has made with the current invention.
- It would be more dangerous for Erickson to make cap 12 a decorative section as a decorative section that contains a gem could be damaged when inserted into a standard ear-piercing device, or it could damage or jam the ear-piercing device, or the decorative element could cause infection to the newly pierced ear.
- It is common practice in the art that a plain gold or stainless element, for example a stud, be worn in a newly pierced ear, for a period of time, while the piercing heals.
- As stated in US patent 6,183,490 to Korbar:

*"The risk of infection is further significantly increased by the typical impatience of individuals who want to change jewelry (i.e., replace the piercing earring) before the pierced tissue fully heals. In fact, to the extent such piercing earring is prematurely removed, the piercing formed by the piercing earring heals and ultimately closes, thus defeating the entire piercing experience. Such problems are especially common among younger individuals. In this regard, the widely acknowledged contributing factor to such problems is the belief of the customer that, after piercing, the pierced hole will be permanent in six weeks, as opposed to the more correct time of six months."*

(column 1, line 65 to column 2 line 15 – Korbar '490)

- Only the current invention, and not an invention created by Hernandez '974 in view of Erickson allows the decorative element to be changed in a body opening, while the opening is still healing and without removing any element that comes in contact with the healing tissue. That is to say, the current invention provides a head section, a body piercing section and an attachment section that may remain in the newly pierced body opening as long as the wearer desires, while allowing the wearer to exchange decorative sections whenever they wish.
- The combination of Hernandez '974 and Erickson do not constitute the current invention, therefore Hernandez '974 in view of Erickson is not *"a body decoration system substantially as claimed"*.

8. In response to "Claim Rejection - §35 USC 103" (item 12) in the Office action:

- Applicant respectfully requests Examiner consider the arguments against Hernandez '974 and Erickson above keeping in mind Hernandez '974 has no head section.
- Regarding Hernandez '974 in view of Erickson and Kowalski '128, Applicant respectfully requests Examiner consider that Hernandez '974 not only does not have a head section, but the element 24 referred to by Examiner would not work as a head section due to the inherent curve of the body piercing section of the current invention. Also, a decorative section of the current invention would face "inward": and would not be visible. Also, as stated above, there is no "fixed connection" for the body piercing section with Hernandez '974's element 24.

9. In response to "Claim Rejection - §35 USC 103" (item 13) in the Office action: Applicant respectfully feels Examiner is evaluating dependent elements of claims 4 and 5 in isolation. Applicant believes claims are patentable over the references when taken as a whole. Applicant respectfully makes reference to MPEP 2106, II., C. "Claims"; (last paragraph)

*"Finally, when evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and*

then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., *Diamond v. Diehr*, 450 U.S. at 188-89, 209 USPQ at 9."

10. In response to "Claim Rejection - §35 USC 103" (item 14) in the Office action: Johnson '492 does not disclose a body decoration system, as does the current invention. Kowalski does not disclose a curved rod in the body opening, the curvature. Even in Kowalski's Figure 5, element 38 is curved throughout its length, however the cross section that is exposed to the body opening (i.e. the ear piecing) is less than approximately 1/8".

Because of this small opening, even the curvature seen in element 38 does not translate any stress nor does the body opening experience the benefit that the curvature of the body piercing of the current invention experiences because, for the opening for the ear, a straight rod is used. As discussed in Applicant's response number 8, above, this curvature of Kowalski is not one that brings advantages and is simply a superfluous design choice.

Further, Applicant respectfully feels Examiner is evaluating dependent elements of claim 11 in isolation. Applicant believes claims are patentable over the references when taken as a whole. Applicant makes reference to MPEP 2106, II., C. "Claims"; (last paragraph)

*"Finally, when evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered. See, e.g., Diamond v. Diehr, 450 U.S. at 188-89, 209 USPQ at 9."*

Applicant believes all objections and rejections of this Office Action have been addressed and as such, applicant respectfully requests that a timely notice of allowance be issued in this case.

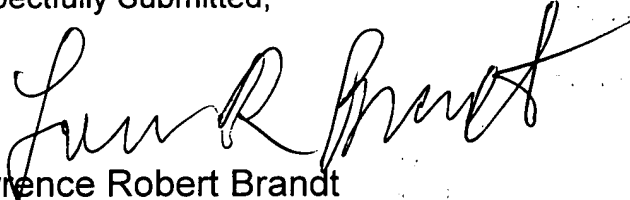
It seems that all references are directed toward earrings installed in ear lobes, in the traditional manner. While an earring is a body piercing, Applicant's current invention is designed for other body piercings, as should be clear by the specification of the application. In an attempt to restrict the claims of the current invention to "not earrings", in the hope of clearing the prior art, Applicant asks Examiner to insert new claim 32 to the current application. If claim 32 is allowable, Applicant reserves the right to narrow certain other of the active claims in a similar manner as claim 32 to seek allowance of these claims.

*Applicant believes the above changes to the claims and specification do not constitute new matter. Applicant respectfully requests Examiner insert these changes into the record.*

If Examiner believes an amended claim or specification would be helpful in granting allowance of one or more claims, Applicant respectfully requests Examiner provide such suggestions via facsimile or voicemail at the contact numbers below.

Applicant thanks Examiner for his work on this application.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Lawrence Robert Brandt", written in a cursive style.

Lawrence Robert Brandt

Agent for Applicant Lasar

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Note: Mr. Brandt's pager is no longer in operation; please use the three contact methods above.